

REMARKS

New claim 31 has been added. The application as amended contains claims 1-31. Support for the new claim appears in the original disclosure, including Figs. 1 and 2, and page 3, lines 18-21, of the specification. Please charge any deficiency in the fees to Deposit Account No. 04-1073.

The present application relates to a method of creating a backup disc, so that the backup disc can be used instead of a hybrid type source disc, to preserve the contents of the source disc safe from damage (specification, page 4, lines 5-11). The method includes the steps of (1) determining whether a target disc is qualified to be the backup disc, (2) loading the contents (i.e., the backup information) from the source disc, and (3) writing the information in the target disc. In operation, the qualification determining step may be performed by comparing a lead-in start time K1 recorded in the source disc to a lead-in start time K2 recorded in the target disc (Fig. 10, S409; Fig. 11, S421, S423; page 39, lines 2-6). The lead-in start time may be specific to each manufacturer (page 27, lines 7-11). This way, the qualification determining step can be used to prevent unauthorized copying (page 39, lines 6-13).

Claims 1-5, 7-14, 16-23 and 25-27 are rejected under 35 U.S.C. 103 as being unpatentable over Gehr in view of Tatano, and further in view of Iida. Reconsideration is respectfully requested. The prior art references, even when considered together, do not suggest the step of “determining whether or not a target optical disc is qualified as the backup disc of [a] hybrid type source optical disc by comparing the source optical disc to the target optical disc based on information recorded in the source optical disc and the target optical disc.” The step is recited in each of claims 1-5, 7-14, 16-23 and 25-27.

Gehr discloses a system for copying information from one disc to another. The Gehr system includes software for determining whether there are one or two disk drives (Fig. 4, 404) and, if there are two drives, whether the drives are of the same type or different (408; column 4, lines 9-12).

Tatano refers to a system for preventing copying from a source medium to a destination medium where document control information recorded in the destination medium does not coincide with document control information recorded in the source medium, up to the final document recorded in the destination medium.

The Office Action's rationale for the rejection of claims 1-5, 7-14, 16-23 and 25-27, especially as it relates to Gehr and Tatano, is not clear. It is especially unclear which reference is supposed to meet the recited "comparing" step. At one point, the focus was on Gehr. In an Office Action mailed February 15, 2007, page 17, it was stated that "[t]he main concept of comparison is already given in Gehr, but the details . . . are not explicitly disclosed." Then, in the outstanding Office Action, mailed August 9, 2007, page 2, it is argued that Tatano "teaches . . . comparing the source optical disk to the target optical disk based on information recorded in the source optical disc and the target optical disc."

In the Request for Reconsideration filed October 12, 2007, Applicant questioned the relationship between Gehr and Tatano, since Tatano has no applicability to determining whether two drives are the same or different. Then, in the Advisory Action mailed October 30, 2007, the rationale for the rejection was changed again. The Advisory Action argued that, "[b]y determining if the drives are compatible, Tatano [sic, Gehr which refers to drives?] teaches a type of comparison."

Applicant respectfully submits that the difficulty that the Office Action has in articulating a rationale for combining Gehr and Tatano stems from the fact that the teachings are not applicable to each other. Gehr relates to determining whether there are one or two disk drives and, if there are two drives, whether the drives are of the same type or different. Gehr cannot meet the limitations of claim 1, since it does not disclose or suggest comparing one disc to another. Gehr might suggest some "type of comparison," but it is not anything like the comparison recited in the claims. Tatano, on the other hand, has nothing to do with drives, but relates to checking information on discs. If Gehr "determines whether two drives are the same or different," what purpose would it serve in Gehr to compare a source optical disc to a target

optical disc? Tatano does not seem to have any applicability to determining whether two drives are the same or different.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.”¹ Here, however, it is not at all clear what the Office Action has in mind. The references are directed toward entirely different, unrelated problems. The proposed combination only starts to make sense with the benefit of hindsight.

Moreover, please keep in mind that the claimed invention relates to a method of creating a backup disc “of a hybrid type source optical disc.” The Tatano system will not permit copying except where document control information recorded in the destination medium coincides with document control information in the source medium. It is not understood how anything reflecting the Tatano system would work if the source medium were a hybrid type disc (as it would have to be to meet the relevant claim limitations). If the source medium were a hybrid type disc, then documents recorded in a read only section of the source medium presumably would be copied into a writable section of the destination medium, and then the document control information of the two disks would not coincide.

Iida does not overcome the deficiencies of Gehr and Tatano. Iida refers to a hybrid disk, but it has nothing to do with copying or creating a backup disc. It adds nothing to the issue of whether it would have been obvious to combine Gehr and Tatano, and it adds nothing with respect to the issue of whether anything in the Tatano system would work if the source medium were indeed a hybrid type disc. Moreover, it becomes impossible to understand the rationale for modifying Tatano in view of Iida in the case where Tatano is already somehow used to modify Gehr. Iida does not provide anything that is applicable to the problems to which Gehr and Tatano are directed. It appears that Iida was cited solely because the claims refer to a hybrid type disc. Applicant’s claims have been used, improperly, as a roadmap, leading the Office

¹ PTO Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57528 (October 10, 2007).

Action simply to pick, choose and lump together disparate teachings. In reality, there is no one who would have undertaken the multi-step combination of modifications suggested by the Office Action in this case, unless they had foreknowledge of Applicant's own invention.

Claims 6, 15 and 24 depend from claims 1, 4, 10, 13, 19 and 22, and should be allowable along with those claims and for other reasons. Therefore, the rejection of claims 6, 5 and 24 should be withdrawn.

Claims 28-30 are rejected under 35 U.S.C. 103 as being unpatentable over Fairman in view of Tatano. Reconsideration is respectfully requested. Claims 28-30 each refer to "creating a backup disc of a hybrid type source optical disc." In addition, the claims each recite the step of "determining that ROM information of the target optical disc is dummy data when the source optical disc and the target optical disc have the same substrate information and a portion of ROM information of the source optical disc and a portion of ROM information of the target optical disc are not the same." Support for the subject matter of claims 28-30 appears, for example, in Fig. 14, steps S523, S527 and S533, although the claimed invention should not be limited to the examples shown in the drawings.

Fairman refers to a method of making a master disc 170 (Fig. 5) for use in producing stampers 174. The master disc 170 is made from data stored on a pre-master disc 164. Where the pre-master disc 164 contains dummy files 162, the master disc 170 contains only ATIP 172. Contrary to the August 9 Office Action, Fairman does not disclose or suggest a method of creating a backup disc of a hybrid type source optical disc. The Fairman master disc 170 is not a "backup disc," and even more clearly it is not a backup disc of the pre-master disc 164. Fairman is believed to be basically unrelated to the claimed invention. Tatano is cited for other features, and does not overcome the deficiencies of Fairman.

The October 30 Advisory Action offered a different rationale for the rejection of claims 28-30, stating that Fairman also teaches making a copy of the master disc 170, "which is a type of a backup for a disc." Actually, Fairman refers to the production of stampers 174 (Fig. 5). In any event, however, making a copy from the master disc 170, to the extent suggested

by Fairman, would not begin to meet the determining step of claims 28-30, and the Office Action offers no explanation to the contrary. Again, Fairman is basically unrelated to the claimed invention.

Dependent claim 31 should be allowable along with claims 1 and 2, and for other reasons. The invention of claim 31 can be used to generate a CD-compatible backup disc, such that the backup disc can be reproduced in players enabling only CD to be reproduced. According to the claimed invention, a determination can be made as to whether a target disc is suitable as a backup disc. The determination may be based on substrate information of the source hybrid disc. If the target disc is a hybrid disc, and if it is determined that the target hybrid disc is suitable as a backup disc, then it is possible to reproduce the backup disc at the boundary between ROM and RAM parts. In other words, it is possible to generate a backup disc that is capable of linking between the RAM part and the ROM part. This is an important advantage when a hybrid disc is being used as the backup disc. Please refer, for example, to Applicant's specification, page 4, lines 23-24. The subject matter of claim 31 is nowhere disclosed or suggested by the prior art references of record, even when such references are considered in combination.

Allowance of the application with claims 1-31 is solicited.

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